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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,892	12/14/2000	Takayuki Yamamoto	Q62230	5759

7590 10/12/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 8/4/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2, 5, 6 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5, 6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes applicants' attempt (Response, page 3, paragraph No. 5) to accept the Examiner's suggestion to use the claim set forth on page 3 of the Office action mailed May 4, 2004, Paper No. 042204 in place of the pending claim 5. However, applicants have followed the wrong procedure in doing this and the Examiner accordingly has decided to proceed in the following manner. The newly presented claim "5" which is believed to be intended as the only claim presently pending in the application will accordingly be renumbered under Rule 126 as claim 6, and applicants should have cancelled the present claim 5 along with their cancellation of claims 1-4. It is noted that the presently pending independent claim 5 contains both the very indefinite and confusing term "final" polymer (which may also be new matter) and it is also noted that there is an apparent typographical error which is present in line 5 where it was stated that there is a "molecular weight of 105 or lower", instead of what is clearly proper and is now presented in the new renumbered claim 6, --a molecular weight of 10^5 or lower--. Accordingly, it is again noted that applicants should now simply cancel claim 5, note that the newly presented "claim 5" has been renumbered as claim 6, and the Examiner will proceed as if claim 6 is the only pending claim

in the application, which is clearly believed to be applicants' intent, such as set forth on page 3 of the response.

Additionally, for purposes of completing the record it is noted that the presently pending and unamended claim 5 is again rejected under all of the various grounds which were set forth in the last Action, Paper No. 042204.

3. Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the characterization of the new polymer as "an obtained" polymer or "the obtained" polymer in claim 6 is believed to be clearly informal for the following reasons. Applicants argue that the "obtained" polymer is meant to determine the polymer "at the end of the reaction" and also that they claim a weight-average molecular weight based on obtained polymers versus EP -470's disclosure of "pre-reaction acrylic polymers" having a certain molecular weight range.

However, the Examiner respectfully notes that there is no reason why, e.g., there cannot be more than one reaction both now and/or later, and this very simple fact clearly makes the use of "obtained" to be vague, indefinite and confusing. In summary, applicants' use of "obtained" polymers appears to have the same flaws as the use of "final" polymer which was utilized in the

last response.

4. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -470 taken in view of applicants' admissions in the specification regarding the usage of pressure sensitive adhesive sheets in semiconductor processing operations as set forth on page 1 and extending to page 2, line 7 of the specification, substantially for reasons of record made throughout the prosecution, together with the following additional observations. The Examiner has little to add except to note that De Simone et al. is again relied upon as evidence of the state of the art disclosing (note particularly the Abstract, column 1 lines 42-56, column 3 lines 3-16, lines 45-56, particularly lines 53-56, and column 7, lines 12-16, particularly line 14) that the resultant properties of acrylic adhesives produced by polymerizing one or more monomers in liquid or supercritical carbon dioxide to form acrylic polymers suitable for usage in reactions forming pressure sensitive adhesives such as set forth in EP -470 is well known in the art. With respect to the remaining limitations, these have been treated as previously set forth below.

5. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time

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policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

October 7, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300
1700

Daniel Zinker